REMARKS

The following Request For Withdrawal Of Finality Of Office Action and Request for Reconsideration are being submitted in response to the Final Office Action issued on November 16, 2004 (Paper No. unknown) in connection with the above captioned patent application, and are being filed within the first month after the three-month shortened statutory period set for a response to the Office Action.

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

The Examiner has made the present Office Action final, apparently on the basis that the present Office Action reasserts the rejections from the previous Office Action, although no reason for finality is in fact stated. However, Applicants respectfully submit that in fact the present Office Action presents several new grounds of rejection that are not made in response to any amendment by Applicants or on any newly submitted Information Disclosure Statement, and accordingly request that the finality of the present Office Action be withdrawn.

In particular, Applicants respectfully point out that the amendments made to the claims of the Application were entered prior to the previous Office Action as part of a Request for Continued Examination filed on February 11, 2004, and that the response to the previous Office Action did not amend the claims. Instead, such response argued against the rejections of the claims only.

Significantly, in issuing the present Office Action, the Examiner newly rejects claim 121 under 35 U.S.C. § 101, where such section 101 rejection has not previously been set forth in the previous Office Action or in any other Office Action in connection with the above-

identified matter. In addition, in issuing the present Office Action, the Examiner newly rejects several of dependent claims 124 and 126-135.

To set forth one example, whereas claim 124 was previously rejected as being obvious over Caronni et al. in view of Onoe et al. or in view of Clark or in view of Coley et al. (May 11, 2004 Office Action, page 2), claim 124 now stands newly rejected as being obvious over Caronni et al. in view of Onoe et al. and further in view of Clark (November 16, 2004 Office Action, page 3). Similar new rejections to claims 127, 129-132 and 135, and 133 and 134 are also set forth in the present Office Action.

Importantly, under MPEP 706.07(a), the present Office Action cannot be made final in view of such new rejections of the claims that are not in response to any prior amendment and that are not based on any newly submitted Information Disclosure Statement. For all of the aforementioned reasons, then, Applicants again respectfully submit that the finality of the present Office Action is premature. As a result, Applicants respectfully request that such finality be withdrawn.

REQUEST FOR RECONSIDERATON

Claims 121, 124, and 126-135 are pending in the present application. No claims have been amended. Applicants again respectfully request reconsideration and withdrawal of the rejection of the claims, consistent with the following remarks.

The Examiner has again rejected claim 121 under 35 USC § 103(a) as being obvious over Caronni et al. (U.S. Patent No. 6,049,878. Applicants again respectfully traverse the § 103(a) rejection.

Independent claim 121 as currently presented recites a computer-readable medium having stored thereon a data structure corresponding to a digital content package. In particular, the data structure includes (three) fields representing:

- encrypted digital content to be rendered in accordance with a corresponding digital license, where the encrypted digital content is decrypt-able according to a decryption key (KD) obtained from the license;
- a content or a package ID identifying one of the digital content and the package; and
- license acquisition information including a location of a license provider for providing the license.

Significantly, the license acquisition information is in an unencrypted form, the license provider location is a network address, and the data structure is provided by a content provider having a public key and a private key, where the data structure further includes a (fourth) field containing the content provider public key.

The Caronni reference discloses a system for secure multicasting from a sender to multiple receivers. Each receiver employs a key management component holding a first key that is shared with the sender and all of the receivers and a second key that is shared with the sender and at least one but less than all of the receivers. The sender has a group key management component with a data structure for storing all of the receivers' first and second keys. According to the Examiner, such data structure and/or the data structure shown in Fig. 6 is representative of a data structure with multiple data fields such as that recited in claim 121.

However, Applicants again point out that although the Caronni reference discloses a data structure, the fields within such data structure do not at all correspond to the fields

within the data structure recited in claim 121. Moreover, and again, Applicants respectfully submit that the recited items of the recited fields cannot be ignored, as the Examiner has done. In particular, according to the Examiner, such items are 'non-functional descriptive material' that do not contribute further to the claimed structure for a computer-readable medium, and therefore the Examiner has not given such items any patentable weight. Applicants again respectfully disagree, for the reasons set forth below.

In pertinent part, Applicants respectfully submit that the items of such fields as recited in claim 121 are not merely statements of intended use. Instead, such items specifically include encrypted digital content, an ID identifying the content or package thereof, license acquisition information, and a content provider public key, all of which are most emphatically not mere 'statements of intended use'.

Instead, the content item is a structure located in a data field, where such structure is recited along with a statement of intended use, i.e., to be rendered in accordance with a corresponding digital license. Further, such content is recited along with a limitation that such content is decrypt-able according to a decryption key (KD) obtained from such a license. Although the recitation of the data field includes a statement of intended use, such statement is with regard to a structure within the data field, i.e. the content, and accordingly the data field does not merely state an intended use.

Similarly, the ID identifying the content or package thereof is a structure located in a data field, where such structure is recited along with a statement of purpose, i.e., to identify the content which was previously recited as being in another data field, or the package. Although the recitation of the data field includes a statement of purpose, such statement is

with regard to a structure within the data field, i.e. the ID, and accordingly the data field again does not merely state an intended use.

Likewise, the license acquisition information includes a location of a license provider for providing the previously mentioned license referenced license ID is a structure located in a data field, the last part of which is a statement of intended use, but which is in connection with a structure comprising information including a location. Although the recitation of the data field includes a statement of intended use, and again, such statement is with regard to a structure within the data field and accordingly the data field again does not merely state an intended use.

Finally, the content provider public key is a structure located in a data field without any particular statement of intended use, but with a statement that such key is provided by a content provider that provides the data structure. At any rate, such statement is with regard to the key within the data field and accordingly the data field again does not merely state an intended use.

Moreover, and again, claim 121 also includes additional structural limitations that are not merely statements of intended use. In particular, claim 121 also recites that the license acquisition information structure is in an unencrypted form, and that the license provider location of the license acquisition information structure is a network address, where such key is provided by a content provider that provides the data structure. One again, although statements of intended use may exist in such additional items, such additional items include structure that cannot be ignored when evaluating the subject matter recited by claim 121.

Thus, Applicants again respectfully submit that the Examiner is incorrect in asserting that the items recited as part of the data structure of claim 121 are 'non-functional descriptive

material' that do not contribute further to the claimed structure for a [computer-readable medium]. Further, Applicants respectfully submit that such items must be given patentable weight.

Applicants also note that in setting forth the Caronni obviousness rejection, the Examiner states to the effect that the limitations set forth in claim 121 do not contribute to a further limitation of the recited computer-readable medium. Applicants respectfully disagree.

In particular, Applicants merely note that such limitations contribute to a limiting of a recited data structure, and that such recited data structure is in turn an inclusion of the recited computer-readable medium. Accordingly, and by extension, such limitations contribute to a limiting of the computer-readable medium which includes the recited data structure.

Thus, Applicants respectfully submit that the Examiner is incorrect in stating to the effect that the limitations set forth in claim 121 do not contribute to a further limitation of the recited computer-readable medium. Further, Applicants again respectfully submit that such limitations must be given patentable weight.

Once again, Applicants respectfully submit that the Examiner has not made a prime facie showing that the Caronni reference makes obvious the computer-readable medium as recited in claim 121. In particular, the Examiner has not made any attempt whatsoever to set forth how the Caronni reference discloses or suggests the recited features of the claims including the items in the recited data structure. Instead, Applicants respectfully submit that the Examiner has impermissibly ignored such items based on an inapplicable argument that such items could be ignored. In point of fact, and as was asserted above, all of such items cannot be ignored inasmuch as such items are within data fields of the recited data structure.

In particular, such a data structure is a permissible form of patentable subject matter under In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Thus, Applicants respectfully submit that the Caronni reference does not make obvious independent claim 121 or any claims depending therefrom. Instead, Applicants respectfully submit that such claims are not in fact obvious in view of the cited Caronni reference, and accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

The Examiner has again rejected claims 124 and 126-135 under a variety of individual rejections under 35 USC § 103(a) as being obvious over the Caronni reference in view of various other combinations of references. Applicants again respectfully traverse the § 103(a) rejections of such claims 126-135.

Applicants respectfully submit that since independent claim 121 is unanticipated and has been shown to be non-obvious, then so too must all claims including claims 124 and 126-135 be unanticipated and non-obvious, at least by their dependency. Thus, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejections of such claims 126-135.

The Examiner has introduced a new ground of rejection by newly rejecting claim 121 under 35 USC § 101 as being non-statutory. Applicants respectfully traverse the § 101 rejection of such claim 121. According to the Examiner, the rejection of claim 121 under section 101 is made for failing to define a concrete, useful, and tangible output as implied (emphasis added) in the previous Office Action.

However, Applicants respectfully submit that according to the aforementioned In re Lowry, a claim to a data structure stored on a computer-readable medium is statutory under

section 101 if the claim represents functional descriptive material that as recorded on the computer medium becomes structurally and functionally related to the medium and the function of the descriptive material becomes realized through the use of technology. 32 F.3d at 1583-84, 32 USPQ2d at 1035. See also MPEP 2106.

Thus, Applicants respectfully submit that claim 121 does indeed represent functional descriptive material that as recorded on the computer medium becomes structurally and functionally related to the medium, and that the function of the descriptive material becomes realized through the use of technology. Moreover, Applicants respectfully submit that so-called Lowry claims such as that represented by claim 121 are well-known as a statutory form of claiming computer-related data structure subject matter. At any rate, any requirement that claimed subject matter be concrete or tangible, if indeed such a requirement even exists, is achieved by reciting that the data structure of claim 121 is in the form of a computer-readable medium such as a memory disk, a memory card, a RAM memory, a memory on a processor, or the like.

For all of the aforementioned reasons, then, Applicants respectfully submit that claim 121 does indeed represent statutory subject matter under section 101. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection.

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 121, 124, and 126-135 is in condition for allowance, and such action is respectfully requested.

Respectfully Submitted,

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